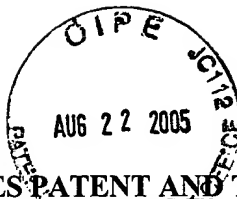


Application No. 09/811,970  
Final Rejection dated: December 21, 2004  
Appeal Brief dated: August 19, 2005



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicants : Thomas Zermani, et. al.  
Serial No. : 09/811,970  
Filed : March 19, 2001  
For : Mechanical Interlock for Filters  
Examiner : Terry K. Cecil  
Art Unit : 1723  
Attorney  
Docket No. : MCA-508

Mail Stop Appeal Brief - Patents  
Commissioner of Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Sir:

**APPEAL BRIEF**

The Appellants hereby submit this brief, in support of the Appellants' appeal from the decision of the Examiner dated December 21, 2004 rejecting claims 1, 11, 16, 24 and 26.

A Notice of Appeal was filed with the U.S. Patent and Trademark Office on June 14, 2005. A Petition for Extension of time under 37 CFR 1.136(a) for filing an Appeal Brief is being submitted concurrently herewith together with the required fees. Authorization to charge the deposit account for the fee for filing a brief in support of an appeal pursuant to 37 C.F.R. §1.17(f) is enclosed.

**I. REAL PARTY IN INTEREST**

As the assignee of the entire right, title and interest in the inventions and improvements which are the subject of this application, Millipore Corporation, a Massachusetts corporation, having a principal place of business at 290 Concord Road Billerica, Massachusetts 01821, is the real party in interest.

## **II. RELATED APPEALS AND INTERFERENCES**

To the best of the Appellants' knowledge, no other appeals or interferences are pending which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

## **III. STATUS OF CLAIMS**

Claims 1, 11, 16, 24, 26 and 27 are pending in the subject application.

Claims 1, 11, 16, 24 and 26 stand rejected and are being appealed.

Claim 27 is allowed.

Claims 2-10, 12-15, 17-23 and 25 are cancelled.

## **IV. STATUS OF AMENDMENTS**

An amendment to claim 27 was filed subsequent to final rejection and was entered upon the filing of the Notice of Appeal.

## **V. SUMMARY OF INVENTION**

A multiple well device with each well having an open top and a closed bottom and one or more holes formed through the closed bottom. (Page 3, Lines 1-7, Figures 1 and 2 elements 1-7). The wells can number from one to 96, 384 or even 1536 in a single device (page 3, line 4, Page 7, Lines 18-21, claim 16, Figure 1, element 2). Each well contains one or more membranes (Page 3, Line 7-9, Figure 1, element 6). The one or more membranes are retained against the bottom of the well by a continuous roll of material from the inner wall of the well (Page 2, lines 3-9, Page 3, Lines 27-31, Figure 2, elements

11, 12 and 13). The roll of material prevents the filter from moving and since apportion of the roll is still attached to the inner wall the result is a sturdy mechanically fixed filter. (Page 2, lines 7-9) As such, a filter can be easily fixed within a well of a device. It can be used with filters that are sensitive to heat to secure them in place, eliminate the need for welding equipment such as sonic welders and eliminate the use of adhesives for bonding the filters in place. (Page 5, Lines 26-29)

## **VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

Claims 1, 11, 16 and 26 stand rejected under 35 USC 102(b) over Bowers (US 5,108, 704).

Claim 24 stands rejected under 35 U.S.C. §103(a) over the combination of each of Bowers (US 5,108, 704) in view of Aysta et.al. (US 5,264,184).

## **VII. ARGUMENTS**

The Appellants believe that the claims consist of three separately patentable groups. Group I consists of claims 1, in which claim 1 is the only independent claim and all other claims in Group I depend therefrom and are not separately patentable therefrom. Group II consists of claim 26, in which claim 26 is the only independent claim. Group III consists of claim 27 which has been indicated as allowed. **The Appellants' claims are not anticipated by Bowers.**

The Examiner rejects claims 1, 11, 16 and 26 under 35 USC 102(b) over Bowers. The examiner states that Bowers teaches a multiwell filtration device including for example 96 wells. The device can be injection molded of plastic. A filter 70 is held against the bottom of the well by a continuous roll of inner wall material formed by shoulder 17 of Bowers. The filter can be made of paper or cellulose acetate.

Appellants respectfully disagree.

**1. The reference does not teach every element of the claims.**

In order to be an anticipatory reference, it is well established case law that a single reference must contain all of the essential claimed elements of the claim in review. See Kloster Speedsteel AB v. Crucible, Inc., 793 F. 2d 1565, 230 USPQ81 (Fed Cir 1986). Bowers fails to do so. In particular, Bowers fails to teach the use of the continuous roll of inner wall material to hold the filter in place against the bottom of the well as is required by the claims.

Bowers is cited in the office action as showing the use of an upper molded plate with a middle portion of the upper plate inner wall of each well having a shoulder, or as described by Bowers “....a smooth “S”-shaped surface 17....” (Column 5, lines 58-59 of Bowers). Nowhere does Bowers teach a continuous roll of inner wall material as is required by the claims.

Moreover, the Figure cited for support in the office action is Figure 11. In this embodiment, Bowers clearly and specifically teaches that it is the annular element 96, the bottom of which is applied to the upper surface of the filter 70 to hold the filter 70 in place.( Column 8, lines 48-63 of Bowers). Nowhere does Bowers teach that the shoulder 17, which is located some ways up the side of the inner wall, holds the filter in place. Bowers clearly and unequivocally teaches and shows to the contrary that the bottom surface of the annular element of the upper plate performs this function. As this feature as well as the shoulder feature itself is not a continuous roll of inner wall material as required by the claims, Bowers fails to teach the claimed element and is not an anticipatory reference. The rejection under 35 USC 102(b) is respectfully requested to be withdrawn.

**B. The Appellants' claims are not obvious over the combination of Bowers in view of Aysta**

The Examiner rejects claim 24 under 35 U.S.C. §103(a) as being unpatentable over the combination of Bowers (US 5,108,704) in view of Aysta et.al.(U.S.5,264,184). The Examiner states that Aysta et al teaches a separation layer 28 held against the bottom of a well by a ring that can be made of a plurality of layers (e.g. bulk material between two porous glass frits) as in claim 24. The Examiner concludes that it would have been obvious to use the plurality of layers of Aysta et al as the filter material 70 of Bowers wherein upon modification the continuous roll formed by the shoulder 17 of Bowers would contact the top surface of the multilayered filter of Aysta since Aysta teaches the benefit of chromatographic properties- desired by Bowers.

Appellants respectfully disagree.

**1. The references do not teach or suggest all the claim limitations**

To establish a prima facie case of obviousness, the prior art must teach or suggest all the limitations of a claim, there must exist a suggestion or motivation in the references themselves or as a matter of general knowledge to modify or combine the references, and there must be a reasonable expectation of success. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). However, the Examiner may not establish obviousness using hindsight or in view of the teachings or suggestions of the Appellants. *Para-Ordnance Manufacturing, Inc. v. SGS Importers International, Inc.*, 73 F.3d 1085, 37 U.S.P.Q.2d 1237 (Fed. Cir. 1995). "To draw on hindsight knowledge of the...invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own reconstruction--an illogical and inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 38 U.S.P.Q.2d 1551 (Fed. Cir. 1996).

All limitations of a claim must be taught or suggested by the cited references to establish prima facie obviousness. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

As discussed above Bowers fails to teach or suggest the use of a continuous roll of inner wall material to hold the membrane in place. Instead it uses an annular member to do so. The combination of Aysta with Bowers fails to overcome this defect and fails to teach or suggest the claimed invention of claim 24 as the combination fails to teach or suggest that one hold a multilayered filter against the bottom of the well by a continuous roll of inner wall material. At best the combination would teach one of ordinary skill in the art to use the annular element 96 of Bowers in lieu of the “rubbery, preferably plastic, retaining ring 30” (Column 6, lines 63-64 of Aysta) that is pressed against the inner wall of the container of Aysta.

It is clear that Bowers and Aysta have a similar but different means from that of the present invention to hold a filter in a well of a container. Both use separately formed, independent elements (ring of Aysta et.al. and annular element of Bowers) rather create a continuous roll of the inner wall material to hold the filter, be it single or multilayered, against the bottom of the well.

In contrast, the present invention is device that uses a portion of the inner wall material in the form of a continuous roll to hold the filter against the bottom of the well. No separate piece or element that could be dislodged is required.

This is completely different from Bowers and Aysta et.al.

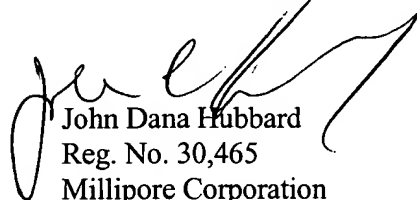
Therefore, for the above reasons, the Examiner has not established that Claim 24 is prima facie obvious in view of the cited references.

### VIII. CONCLUSION

For the reasons set forth above, the Appellant requests that the Examiner's rejection of claims 1, 11, 16 and 26 under 35 USC 102(b) be reversed; that the Examiner's rejection of claim 24 under 35 U.S.C. §103(a) be reversed; and that all pending claims be allowed.

Date: August 19, 2005

Respectfully submitted,



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CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)

The undersigned hereby certifies that this document is being placed in the United States mail with first-class postage attached, addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on August 19, 2005.



Stacey Gross

## CLAIMS APPENDIX

1). A filtration device comprising at least one well, each well having an open top and a closed bottom having one or more holes which allow liquid to pass through and an inner wall, at least one piece of filter positioned within each well and against the bottom of each well and a continuous roll of inner wall material of the well positioned against a top of the filter to hold the at least one filter piece in place and said well being formed of a plastic.

11. The device of claim 1 wherein the one or more pieces of filter are made from a polymeric material selected from the group consisting of cellulose acetate, polysulphones, polyethersulphones, polyarysulphones, polyvinylidene fluoride, polyolefins, polyamides, PTFE resin, thermoplastic fluorinated polymers and polycarbonates.

16. The device of claim 1 wherein the device has a number of wells selected from the group consisting of 96, 384 and 1536.

24. The device of claim 1 wherein the at least one piece of filter are multiple pieces with the continuous roll of material on top of the upper surface of the uppermost filter.

26. A filtration device comprising 96 wells, each well having an open top and a closed bottom having one or more holes which allow liquid to pass through, at least one piece of filter positioned within each well and against the bottom of each well and a continuous roll of inner wall material of the well positioned against a top of the at least one piece of filter and said well being formed of a plastic.

27. A filtration device comprising at least one well, each well having an open top and a closed bottom having one or more holes which allow liquid to pass through, at least one piece of



filter positioned within each well and against the bottom of each well and a continuous roll of inner wall material of the well positioned against a top of the filter, said well being formed of a plastic and wherein the at least one piece of filter are multiple pieces sequentially arranged in the well and sealed to the well by a continuous roll of inner wall material of the well positioned and formed between each piece of filter and on top of the uppermost piece of filter.

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## EVIDENCE APPENDIX

No evidence is being submitted with the present Appeal Brief.

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#### RELATED PROCEEDINGS APPENDIX

No related appeals or interferences are pending submitted in the present Appeal Brief.